UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,348	08/03/2001	Dana Borger	020748.0224PTUS	7283

44124 7590 12/01/2006		EXAMINER
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DALLAS, TX 75201	ART UNIT	PAPER NUMBER
	2152	

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/922,348	BORGER ET AL.
	Examiner	Art Unit	
	Dohm Chankong	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>18 September 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-62</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-62</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1>   This action is in response to Applicant's request for continued examination. No

claims are amended. Claims 1-62 are presented for further examination.

2>   This is a non-final rejection.

Continued Examination Under 37 CFR 1.114

3>   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant

to 37 CFR 1.114. Applicant's submission filed on 9.18.2006 has been entered.

Priority

4>   The priority date of Applicant's application is August 3, 2001 because the instant

application is not entitled to the priority date of its provisional application, 60/224,152. The

effective filing date [of an application] is the filing date of the provisional application for any

claims which are fully supported under the first paragraph of 35 U.S.C. 112 by the provisional

application. MPEP §706.02(V)(D). That is, the instant application is only entitled to the

priority date of the provisional application if the provisional application fully supports the

claims under the written description and enablement requirements of 35 U.S.C §112.

Here, the provisional application fails to provide a supporting written description and also would not enable one of ordinary skill in the art to make and use the invention. The provisional application consists of 3 pages of generic description for an invention that combines voice portal and advertising methodology. The primary focus of the provisional is on providing interactive advertisements; the provisional discusses in broad strokes the purpose of the invention and various features but lacks any descriptive material as to specific elements and functionality as seen in the claims of the instant application. The provisional application's disclosure does not provide adequate written description of the claimed limitations nor would it have enabled one of ordinary skill in the art to make and use the claimed invention.

For example, claim 1 discusses a text-to-speech transcoder, retrieving advertisements from a server, inserting the advertisements within requested web content and then forwarding the now combined content and advertisement to the transcoder for conversion to audio format. There is nothing in the provisional application that could be construed as supporting these features; there is no discussion of a transcoder, an advertisement server that stores advertisements in text-based format or converting the content and advertisements from text into an audio format.

Because each claim limitation is not supported by the disclosure of the provisional application, the instant application is not entitled to the priority date of the provisional. Instead, the instant application the priority date of the instant application is the filing date of the application, August 3, 2001. Therefore, the Wu reference qualifies as prior art against the instant application.

Response to Arguments

5>   Applicant's arguments have been considered but are moot in view of the new grounds

of rejection set forth in this action.

6>   With respect to claim 9, Applicant argues that Logan fails to disclose notifying the

advertisement server of user interaction with an advertisement. In the Office's view, Logan's

teaching that the advertisement server keeps track of, for example, the volume and the

playing speed at which the user listened to the advertisement can be interpreted as "user

interaction" with the advertisement. That is, the user interacted with the advertisement by

adjusting the volume at which the advertisement was played on his computer. Logan also

teaches tracking which advertisements that a user skipped [column 28 «lines 51-57»].

Therefore, Logan's teaching of tracking the volume at which the advertisement was played

and which advertisements that a user skipped is interpreted as "user interaction".

7>   Applicants note that Logan teaches performing translation of text into audio at the

client device which is contrary to Applicant's claim. The current rejection should overcome

this concern. The new prior art teaches performing the translation of text into audio to play

over a cellular telephone network to a user. While Logan is still relied upon as a secondary

teaching, Logan is not relied upon to teach conversion of text. Instead, Logan is relied upon

to teach advertisements and advertising servers in a text-to-audio system.

It should be noted however that, unlike claims 1 and 9, this feature is not present in

claim 57. Claim 57 does not disclose translating the web content and advertisement at the

server.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8>   Claims 1-56 are rejected under 35 U.S.C § 103(a) as being unpatentable over Dames et

al, U.S Patent Publication No. 2002|0129067 ["Dames"], in view of Logan et al, U.S Patent.

6.199.076 ["Logan"].

9>   As to claim 1, Dames discloses a computer system configured to integrate advertising

within Web content requested by users, comprising:

a text-to-speech transcoder [0011, 0028], comprising:

means for converting Web content from a text-based format to an audio

format [0011, 0026, 0040]; and

means for serving Web content in an audio format to a user client device via

telephone link with the user client device [0007]; and

a Web server that hosts Web content in a text-based format [0009, 0010 : server

implied because Dames discloses HTML formatted content], comprising:

means, responsive to a user request via the client device for Web content, for

retrieving related content[0027, 0040 where: Dames discloses responsive to a user

request, related content is retrieved to be placed into the template in place of the

content markers];

means for inserting the retrieved advertisement within the user requested

Web content [0040 : inserting text related to requested content (weather)]; and

means for forwarding the user requested Web content and related content to

the text-to-speech transcoder for conversion to an audio format and subsequent

delivery to the user client device [0051 : "end user can listen to the content over a

cellular telephone connection"].

Dames does not expressly disclose an advertisement server or inserting

advertisements into the user requested content.

10>   In the same field of invention, Logan is directed a system for playing audio segments

over a network and provides an implementation of converting text files into speech [see

abstract]. Logan discloses:

an advertisement server that host advertisements in a text-based format [Figure 1

«item 135» | column 5 «lines 47-59»]; and

inserting advertisements within the Web content [column 11 «lines 29-37»].

Logan discloses that the benefits of advertisements in a text-to-audio system include

providing a means of defraying subscription costs and enabling companies to provide

targeted advertising [column 44-67»].

As noted, Dames does disclose retrieving user request related textual content and then inserting the textual content into the requested content. Based on Logan's disclosure, it would have been obvious to one of ordinary skill in the art to implement advertising into Dames' system. Dames already discloses inserting related content, such as sports scores, weather and financial news [0027, 0040]; the combination of Dames and Logan thus would provide a transcoding system whereby related advertising (content) is inserted into user requested Web content before it is played over a cellular telephone connection to a user.

11>   As to claim 2, Dames discloses selecting related content for insertion within user-requested web content in response to a user request for web content [0040].

Dames does not expressly disclose an advertisement server.

12>   Further, Logan discloses utilizing an advertisement server [Figure 1 «item 130»]. It would have been obvious to one of ordinary skill in the art to have implemented Logan's advertisement server into Dames in order to incorporate advertisement functionality into Dames' text-to-speech system. Benefits from a combination include providing a means of defraying subscription costs and enabling companies to provide targeted advertising [Logan, column 44-67»].

13>   As to claim 3, Dames discloses retrieving content having a format and size compatible with user-requested Web content when the Web content is converted to an audio format [0040]. Dames does not disclose advertisements.

Logan discloses wherein means for selecting advertisements for insert within user-requested Web content comprises means for retrieving advertisements having a format and size compatible with user-requested Web content when the web content is converted to an audio format [Figure 4 | column 18 «lines 21-45» | column 25 lines 35-50 where : Logan discloses the advertisements are inserted into a schedule table with the regular content, the advertisements in audio format like the requested content. The table ensures that the advertisements are of "compatible" size with the content as well].

Both Dames and Logan are concerned with providing content that will be compatible with the user-requested content [see Dames, 0011]. It would have been obvious to one of ordinary skill in the art to incorporate Logan's advertisement scheduling functionality into Dames' system to insure that advertisements (content) inserted into content are compatible with the web content.

14>   As to claim 4, Dames does not disclose the advertisement having a predetermined time length.

15>   Logan discloses retrieving an advertisement having a predetermined time length when delivered in an audio format [Figure 4 | column 18 «lines 21-45» | column 23 «lines 40-45» | column 24 «lines 9-31» | column 25 lines 35-50 | column 34 «lines 24-44» where : the advertisement is defined as a segment of content]. It would have been obvious to one of ordinary skill in the art to incorporate Logan's advertisement segments of predetermined

length into Dames' system to provide related content that is consistent with the user-

requested content.

16>   As to claim 5, Dames discloses the text-based format comprising VXML format

[0026].

17>   As to claim 6, Dames does not disclose an advertisement server.

18>   Logan discloses an advertisement server further comprising means for storing

information associated with serving an advertisement to a user [Figure 1 «item 130» | column

5 «lines 47-59» where : item 130 corresponds to an advertising server]. It would have been

obvious to one of ordinary skill in the art to incorporate Logan's advertising server into

Dames to provide a central location for storing advertisements. Such an implementation is

desirable for allowing quicker and more efficient access to advertisements.

19>   As to claim 7, Dames does not expressly disclose means for determining if a user

listened to an advertisement in its entirety.

20>   Logan discloses means for determining if a user listened to an advertisement in its

entirety [column 10 «lines 21-29» | column 28 «lines 24-41» : "start and end times"]. It would

have been obvious to incorporate Logan's billing techniques into Dames to insure that

subscriber billing is accurate and based on the viewing of advertisements of the users [see

Logan, column 28 «lines 42-65»].

21>   As to claim 8, Dames does not expressly disclose means for determining how many

times a user listened to an advertisement.

22>   Logan discloses means for determining how many times a user listened to an

advertisement [column 28 «lines 6-65»]. It would have been obvious to incorporate Logan's

billing techniques into Dames to insure that subscriber billing is accurate and based on the

viewing of advertisements of the users [see Logan, column 28 «lines 42-65»].

23>   As to claim 9, as it substantially has the limitations of claim 1, see the rejection of

claim 1, above, under Jimenez and Logan. Claim 9 differs primarily because it is directed

towards interactive advertisements. Logan teaches interactive advertisements [column 27

«lines Logan discloses means for notifying the advertisement server of user interaction with

an advertisement [column 28 «lines 6-65»]. It would have been obvious to incorporate

Logan's billing and advertisement functionality into Dames to insure that subscriber billing

is accurate and based on the viewing of advertisements of the users [see Logan, column 28

«lines 42-65»].

24>   As to claim 10, Dames does not teach the claimed limitations.

25>   Logan teaches:

means for retrieving additional information associated with an advertisement in response to user interaction with the advertisement [column 10 «lines 44-67» | column 31 «lines 14-62»]; and

means for delivering the additional information to the user client device in an audio format [column 31 «lines 14-62» where : hyperlinks retrieve further content. Logan teaches throughout his disclosure that his content includes text and audio format content].

It would have been obvious to one of ordinary skill in the art to incorporate Logan's interactive advertisements into Dames to enable additional content that is relevant to the user's interests to be retrieved, ensuring targeted advertisements and information.

26>   As to claim 11, Dames does not teach the claimed limitations.

27>   Logan teaches :

means for recognizing one or more key words spoken by the user during delivery of an advertisement [column 31 «lines 48-62» : "voice command response"]; and

means for redirecting the user client device to additional audio content associated with the advertisement in response to recognition of one or more key words spoken by the user [column 31 «lines 14-62» where : hyperlinks retrieve further content. Logan teaches throughout his disclosure that his content includes text and audio format content].

It would have been obvious to one of ordinary skill in the art to incorporate Logan's interactive advertisements into Dames to enable additional content that is relevant to the user's interests to be retrieved, ensuring targeted advertisements and information.

28>   As to claim 12, Dames does not disclose means for retrieving additional information from the advertisement server.

29>   Logan discloses means for retrieving additional information in response to user interaction comprises means for retrieving additional information from the advertisement server [column 3 «lines 22-31» | column 17 «lines 18-27»]. It would have been obvious to one ordinary skill in the art to modify Dames with Logan's advertisement interaction functionality. It would have been obvious to one of ordinary skill in the art to incorporate Logan's interactive advertisements into Jimenez to enable additional content that is relevant to the user's interests to be retrieved, ensuring targeted advertisements and information.

30>   As to claims 13 and 31, as they do not teach or further define over the previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claim 2.

31>   As to claims 14, 15, 21, 22, 32, 33, 40, 41, 50 and 51, as they do not teach or further define over the previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claims 3 and 4.

32>   As to claims 16, 23, 34, 42 and 52, as they do not teach or further define over the

previously claimed limitations, they are similarly rejected for at least the same reasons set

forth for claim 5.

33>   As to claims 17-19, 24-26, 35-38, 43-45, and 53-56, as they do not teach or further define

over the previously claimed limitations, they are similarly rejected for at least the same

reasons set forth for claims 6-8.

34>   As to claims 20, 27, 39 and 46, as they do not as it does not teach or further define over

the previously claimed limitations, they are similarly rejected for at least the reasons set forth

for claims 1 and 9.

35>   As to claims 28 and 47, as they do not teach or further define over the previously

claimed limitations, they are similarly rejected for at least the reasons set forth for claim 10.

36>   As to claims 29 and 48, as they do not teach or further define over the previously

claimed limitations, they are similarly rejected for at least the same reasons set forth for

claim 11.

37>   As to claims 30 and 49, as the y do not teach or further define over the previously

claimed limitations, they are similarly rejected for at least the same reasons set forth for

claim 12.

38>   Claim 57-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu, U.S

Patent Application No. 2003|0212759, in view of Logan.

39>   In regards to claim 57, Wu discloses a advertising server (figure 4-#54) that integrates

interactive advertising within Web content requested by users ([0027] lines 12-15, [0032] lines

1-6), comprising:

means for selecting an advertisement for insertion within Web content requested by a

user via a client device [0027, 0032] in communication with a Web server (figure 4), wherein

the advertisement has a text-based format ([0025] lines 29-31) and is configured to be

interactive when converted to an audio format;

means for forwarding the selected advertisement to the Web server for insertion

within the Web content requested by the user [0020, 0032 : delivered "in-band" with the

requested content]; and

means for receiving notification([0030], [0041] lines 17-30) from a text-to-speech

transcoder (i.e. audio channel on or off) that the selected advertisement has been delivered to

the user client device in an audio format ([0039] lines 8-12).

40>   Wu is silent on means for storing information associated with delivery of the advertisement to the user client device.

In the same field of invention, Logan discloses interactive advertisements and storing information associated with delivery of the advertisement to the user client device [column 27 «line 58» to column 28 «line 65» where the server stores information about how the user played the advertisement such as volume and whether any ads were skipped]. It would have been obvious to one of ordinary skill in the art to incorporate Logan's advertisement tracking functionality into Wu's advertising system to benefit the companies by providing useful information to better target and utilize their advertisements [see Logan, column 28 «lines 42-57»].

41>   In regards to claim 58, Wu does not disclose storing information associated with user interaction. Logan discloses storing information associated with user interaction with the advertisement [column 22 «lines 20-25» | column 28 «lines 6-65»].

42>   In regards to claim 59 Wu discloses the advertisement server of claim 57, further comprising means for providing additional information associated with the advertisement to the user client device in response to user interaction with the advertisement ([0027] lines 12 – 24, [0041] lines 6-20).

43>   As to claims 60 and 61, Wu does not expressly disclose retrieving advertisements

having a format and size compatible with the user requested content or the advertisements

having a predetermined time length.

44>   As to claim 60, Logan discloses wherein means for selecting advertisements for insert

within user-requested Web content comprises means for retrieving advertisements having a

format and size compatible with user-requested Web content when the web content is

converted to an audio format [Figure 4 | column 18 «lines 21-45» | column 25 lines 35-50 where

: Logan discloses the advertisements are inserted into a schedule table with the regular

content, the advertisements in audio format like the requested content. The table ensures

that the advertisements are of "compatible" size with the content as well].

As to claim 61, Logan discloses retrieving an advertisement having a predetermined

time length when delivered in an audio format [Figure 4 | column 18 «lines 21-45» | column 23

«lines 40-45» | column 24 «lines 9-31» | column 25 lines 35-50 | column 34 «lines 24-44» where

: the advertisement is defined as a segment of content].

It would have been obvious to one of ordinary skill in the art to incorporate Logan's

advertisement scheduling functionality into Dames' system to insure that advertisements

(content) inserted into content are compatible with the web content. Ensuring compatibility

is both desirable and advantageous to the user and the content provider.
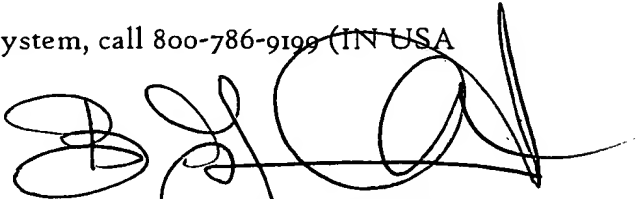
45>   In regards to claim 62, Wu discloses the advertisement server of claim 57, wherein the

text-based format comprises voice extensible markup language (VXML) format ([0028] lines

11-17).

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942.

The examiner can normally be reached on Tuesday-Friday [7:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

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9197 (toll-free). If you would like assistance from a USPTO Customer Service

Representative or access to the automated information system, call 800-786-9199 (IN USA

OR CANADA) or 571-272-1000.

BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER

DC